

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q92617

Michel MONNERAT, et al.

Appln. No.: 10/566,709

Group Art Unit: 3662

Confirmation No.: 9002

Examiner: Harry K. Liu

Filed: February 1, 2006

For: DETERMINING MOBILE TERMINAL POSITIONS USING ASSISTANCE DATA
TRANSMITTED ON REQUEST

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated February 6, 2009, Applicants file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicants turn now to the rejections at issue:

Claims 1-38 and 44-49 constitute all currently pending claims in the application.

I. Claim Rejections under 35 U.S.C. § 102

Claims 1-5, 7, 15-17, 19-21, 35, 37-38, 46-47 and 49 stand rejected under 35 U.S.C.

§ 102(a) as allegedly being anticipated by Sheynblat (U.S. Publication No. 2005/192024).

Applicant respectfully traverses the rejection.

Claim 1 recites, inter alia, the following:

iii) a signal replica is determined for each pair of hypotheses corresponding to said estimated positions and distances and to said associated Doppler effects over a selected time interval, and

iv) the pair of hypotheses corresponding to the signal replica having a maximum correlation with the signal received during said time interval is selected in order to determine said pseudo-random codes modulating said received signals.

The above-quoted portion of claim 1 recites determining a signal replica “for each pair of hypotheses . . . over a selected time interval” and selecting “the pair of hypotheses corresponding to the signal replica having a maximum correlation with the signal received during said time interval.”

Sheynblat does not disclose determining signal replicas for selected time intervals, and does not disclose any information about how it selects which signal replica to apply. Sheynblat also fails to disclose multiple signal replicas, from which one is selected. In fact, Sheynblat does not appear to discuss signal replicas at all, much less selecting a signal replica “having a maximum correlation with the signal received during” a selected time interval, as required by claim 1.

Furthermore, in the “Response to Arguments” portion of the Final Office Action of February 6, 2009, the Examiner straightforwardly concedes that “Sheynblat does not specifically disclose ‘pair of hypotheses.’” (emphasis added.) However, the Examiner appears to contend that certain of the above-quoted features of claim 1 are inherent to the system of Sheynblat.

When “relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.” MPEP § 2112[IV] (emphasis modified) (citations omitted). The Examiner has not, as of yet, provided evidence or

reasoning sufficient to support an argument that the above-quoted features of claim 1 are inherent (i.e., strictly necessary) in all satellite interactions of the type described in Sheynblat

Furthermore, in the Advisory Action of May 18, 2009, the Examiner concedes that “Sheynblat . . . does not specifically disclose ‘signal replicas,’” but states that this feature is well known in the art. (emphasis added.) However, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)) (emphasis added). In rare cases, a secondary reference may be used to show inherency; however, the Examiner here is not suggesting inherency, since “signal replicas” are not strictly necessary to Sheynblat. MPEP § 2131.01 (“a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to . . . [s]how that a characteristic not disclosed in the reference is inherent.” The Examiner, here, merely attempts to take Official Notice that the use of “signal replicas” is “well known,” which is unsupported by any cited reference.

Thus, Sheynblat fails to identically disclose each and every required element of independent claim 1 and, therefore, fails to anticipate claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 1 and its dependent claims 2-5, 7, 35, 37, and 38 be withdrawn.

Independent claim 15 recites features similar to those of claim 1. Claim 15 is, therefore, also patentable at least for reasons analogous to those set forth above regarding claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 15 and its dependent claims 16, 17, 19-21, 46, 47, and 49 be withdrawn.

II. Claim Rejections under 35 U.S.C. § 103

A. Sheynblat

Claims 1-4, 6, 11-13, 15-16, 18, 23, 36, and 46-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat (U.S. Publication No. 2005/0192024). Applicant respectfully traverses the rejection.

Above, Applicant pointed out that Sheynblat is deficient vis-à-vis independent claims 1 and 15. Furthermore, although insufficient to overcome the deficiencies of Sheynblat in this instance, the Examiner appears to rely upon official notice to argue that various features would have been obvious to one of skill in the art, but fails to provide references in support of any such arguments. The MPEP clearly states that “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03[A].

Therefore, claims 1-4, 6, 11-13, 15-16, 18, 23, 36, and 46-47 would not have been obvious within the meaning of 35 U.S.C. §103(a). Additional, untaught modifications would have been necessary. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-4, 6, 11-13, 15-16, 18, 23, 36, and 46-47.

B. Sheynblat and Jolley

Claims 8, 22, 26-34, 44-45 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat (U.S. Publication No. 2005/0192024) as applied to claim 1 above, and further in view of Jolley (U.S. Patent No. 6,323,803). Applicant respectfully traverses the rejection.

Above, Applicant pointed out that Sheynblat is deficient vis-à-vis independent claims 1 and 15. Applicant respectfully submits that Jolley fails to compensate for the deficiencies of Sheynblat. Therefore, claims 8, 22, 26-34, 44-45 and 48 would not have been obvious within the meaning of 35 U.S.C. §103(a). Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 8, 22, 26-34, 44-45 and 48.

C. Sheynblat and Tzamaloukas

Claims 14 and 24-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat (U.S. Publication No. 2005/0192024) as applied to claim 1 above, and further in view of Tzamaloukas (U.S. Publication No. 2004/0230345). Applicant respectfully traverses the rejection.

Above, Applicant pointed out that Sheynblat is deficient vis-à-vis independent claims 1 and 15. Applicant respectfully submits that Tzamaloukas fails to compensate for the deficiencies of Sheynblat. Therefore, claims 14 and 24-25 would not have been obvious within the meaning of 35 U.S.C. §103(a). Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 14 and 24-25.

Respectfully submitted,

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